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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/701,586

11/30/2000

Michael Kock

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06/14/2005

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EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,586

Applicant(s)

KOCK ET AL.

Examiner

Richard G. Hutson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-32 is/are pending in the application.
- 4a) Of the above claim(s) 5-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicants amendment of claims 1-3 in the paper of 3/25/2005, is acknowledged.

Claims 1-3 and 5-32 are still at issue and are present for examination.

Applicants' arguments filed on 3/25/2005, have been fully considered and are deemed to be persuasive to overcome some of the rejections previously applied. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claims 5-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2 and 3 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection is stated in the previous office actions. In response to this rejection applicants have not amended claims 2 and 3, but continue to argue the rejection.

Applicants continue to submit that the rejection is in error on the basis that claims 2 and 3 depend on claim 1 and "i.e. they have a narrower scope".

Applicants complete response has been carefully read and found non-persuasive. As stated previously, claims 2 and 3 are not drawn to "the PARP homolog

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of claim 1", but rather to "a functional equivalent of a PARP homolog as claimed in claim 1". Thus claims 2 and 3 are not necessarily limited to all of the limitations of the PARP homolog of claim 1, but rather a functional equivalent of a PARP homolog of claim 1.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 3 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection was stated in the previous office actions. In response to the rejection applicants have not amended claims 2 and 3, but merely continue to argue the rejection as it applies to the claims. It is noted that applicants appear to argue both the rejections under scope of enablement and written description together.

Applicants submit that the rejection is based on a lack of support for those embodiments having 85% homology of the specified SEQ ID NOs and point the examiner to homology data found on pages 19 and 20 of the specification comparing the sequences of PARP 1, PARP2 and PARP3.

Applicants complete argument is acknowledged, however, found non-persuasive. As previously stated the basis of the rejection is that applicants have not adequately

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described the claimed genus of functional equivalents of PARP homologs (See also above 112 second paragraph rejection).

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at www.uspto.gov.

Claims 2 and 3 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a PARP homolog comprising the amino acid sequence of SEQ ID NO: 2, does not reasonably provide enablement for any functional equivalent of a PARP homolog. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

This rejection was stated in the previous office actions. In response to the rejection applicants have not amended claims 2 and 3, but merely continue to argue the rejection as it applies to the claims. It is noted that applicants appear to argue both the rejections under scope of enablement and written description together.

As above, applicants submit that the rejection is based on a lack of support for those embodiments having 85% homology of the specified SEQ ID NOs and point the examiner to homology data found on pages 19 and 20 of the specification comparing the sequences of PARP 1, PARP2 and PARP3.

Applicants complete argument is acknowledged, however, found non-persuasive. As previously stated the basis of the rejection is that applicants have not adequately

enabled the claimed genus of **functional equivalents** of PARP homologs (See also above 112 second paragraph rejection).

Thus claims 2 and 3 remain rejected.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2 and 3 remain rejected under 35 U.S.C. 102(a) as being anticipated by Thibodeau et al. (Biochem. Cell. Biol. Vol 67 pages 653-660, 1989).

This rejection was stated in the previous office actions. In response to the rejection applicants have not amended claims 2 and 3, but merely continue to argue the rejection as it applies to the claims

Applicants submit since claim 1 has been found to be novel, claims 2 and 3 by their dependence on claim 1 are thus narrower and also novel.

As above, applicants complete argument is acknowledged, however, found non-persuasive on the basis that the limitations of claim 1 are not necessarily incorporated into claims 2 and 3, since claims 2 and 3 each recite "the functional equivalents of a PARP homolog as claimed in claim 1" (See also above discussions under 112 1st and 112 2nd paragraph rejections). Thus Thibodeau et al. continues to anticipate claims 2 and 3.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

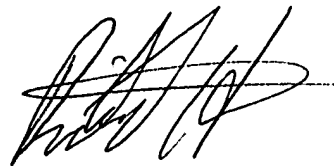
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard G. Hutson whose telephone number is (571) 272-0930. The examiner can normally be reached on 7:30 am to 4:00 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Richard G. Hutson', with a stylized flourish at the end.

Richard G Hutson, Ph.D.
Primary Examiner
Art Unit 1652

rg
6/2/2005